

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 20

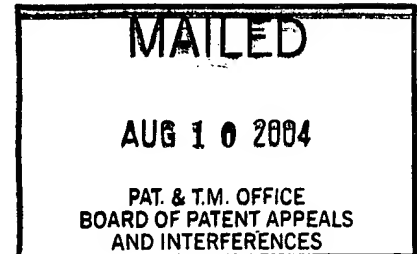
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HEATH HUNNICUT and JOHN F. LUDEMAN

Appeal No. 2003-1025
Application No. 09/224,918

ON BRIEF



Before SMITH, RUGGIERO, and MACDONALD, **Administrative Patent Judges**.

MACDONALD, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1, 3-5, 7-11, 14-15, 17-25, and 28-49. Claims 2, 6, 12, 13, 16, 26, and 27 have been canceled.

Invention

Appellants' invention relates to the control of access by users of the resources on a server. When a user is granted access to a resource by an access granting process, an access-permission is stored in a cache. On a subsequent access request by the same user for the same resource, the cache is

checked to see if an access-permission has already been granted. If it has, then access is granted again without going through the access granting process. If it has not, then the access granting process is run. Access-permissions are checked on a regular basis. An access-permission is flushed out of the cache when its resource is altered, when its user is removed from the system, or when the access-permission of its user is altered. Appellants' specification at page 1, lines 7-8; page 3, line 21, to page 4, line 17; and page 18, line 10, to page 19, line 3.

Claim 1 is representative of the claimed invention and is reproduced as follows:

1. A computer-readable medium having a plurality of executable instructions at least a subset of which, when executed, implement a method comprising:

upon receipt of an indication from a user having access to a computer network to access a resource on the computer network, checking a first memory, without performing a file open procedure upon a file in which are stored any access permissions of users for access to the resource, to determine:

if:

the requested resource is altered; or

a representation of the user has been removed from the first memory; or

any of the access permissions of the user for access to the requested resource are altered:

then removing any access permissions from the first memory allowing access to the requested resource by the user;

Appeal No. 2003-1025
Application No. 09/224,918

else, if:

the first memory indicates that the user has previously accessed the resource:

then providing the user with access to the requested resource.

References

The references relied on by the Examiner are as follows:

Wobber et al. (Wobber)	5,235,642	Aug. 10, 1993
Carlson et al. (Carlson)	5,506,961	Apr. 9, 1996

Rejections At Issue

Claims 1, 3-5, 7-11, 14-15, 17-25, and 28-49 stand rejected under 35 U.S.C. § 112, ¶ 1, as failing to comply with the written description requirement as the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Claims 1, 3-5, 7-11, 14-15, 17-25, and 28-49 stand rejected under 35 U.S.C. § 112, ¶ 2, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 3, 7-11, 14-15, 17, 20-25, and 28-49 stand rejected under 35 U.S.C. § 103 as being obvious over Wobber.

Appeal No. 2003-1025
Application No. 09/224,918

Claims 4, 5, 18, and 19 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Wobber and Carlson.

Throughout our opinion, we make references to the Appellants' brief, and to the Examiner's Answer for the respective details thereof.¹

OPINION

With full consideration being given to the subject matter on appeal, the Examiner's rejections and the arguments of the Appellants and the Examiner, for the reasons stated *infra*, we affirm the Examiner's rejection of claims 1, 3-5, 7-11, 14-15, 17-25, and 28-49 under 35 U.S.C. § 112, ¶ 1; we reverse the Examiner's rejection of claims 1, 3-5, 7-11, 14-15, 17-25, and 28-49 under 35 U.S.C. § 112, ¶ 2; and we reverse the Examiner's rejection of claims 1, 3-5, 7-11, 14-15, 17-25, and 28-49 under 35 U.S.C. § 103.

Appellants have indicated that for purposes of this appeal the claims stand or fall together in five groupings:

Claims 1, 3-5, 7-11, 14-15, 17-25, and 28-49 as Group I with respect to the rejection under 35 U.S.C. § 112, ¶ 1;

Claims 1, 3-5, 7-11, 14-15, 17-25, 28-36, and 41 as Group II with respect to the rejection under 35 U.S.C. § 112, ¶ 2;

¹ Appellants filed an appeal brief on August 26, 2002. The Examiner mailed out an Examiner's Answer on October 16, 2002.

Appeal No. 2003-1025
Application No. 09/224,918

Claims 37-40 and 42-49 as Group III with respect to the rejection under 35 U.S.C. § 112, ¶ 2;

Claims 1, 3, 7-11, 14-15, 17, 20-25, and 28-49 as Group IV with respect to the rejection under 35 U.S.C. § 103; and

Claims 4, 5, 18, and 19 as Group V with respect to the rejection under 35 U.S.C. § 103.

See pages 4-5 of the brief. Furthermore, Appellants argue each group of claims separately and explain why the claims of each group are believed to be separately patentable. See pages 5-17 of the brief. Appellants have fully met the requirements of 37 CFR § 1.192 (c)(7) (July 1, 2002) as amended at 62 Fed. Reg. 53169 (October 10, 1997), which was controlling at the time of Appellants' filing of the brief. 37 CFR § 1.192 (c)(7) states:

Grouping of claims. For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

Appeal No. 2003-1025
Application No. 09/224,918

We will, thereby, consider Appellants' claims as standing or falling together in the five groups noted above, and we will treat:

Claim 1 as a representative claim of Group I;

Claim 1 as a representative claim of Group II;

Claim 37 as a representative claim of Group III;

Claim 1 as a representative claim of Group IV; and

Claim 4 as a representative claim of Group V.

If the brief fails to meet either requirement, the Board is free to select a single claim from each group and to decide the appeal of that rejection based solely on the selected representative claim. ***In re McDaniel***, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002). ***See also In re Watts***, 354 F.3d 1362, 1368, 69 USPQ2d 1453, 1457 (Fed. Cir. 2004).

I. Whether the Rejection of Claims 1, 3-5, 7-11, 14-15, 17-25, and 28-49 Under 35 U.S.C. § 112, ¶ 1 is proper?

It is our view, after consideration of the record before us, that claims 1, 3-5, 7-11, 14-15, 17-25, and 28-49 fail to comply with the written description requirement as the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Accordingly, we affirm.

Appeal No. 2003-1025
Application No. 09/224,918

Throughout Appellants' arguments they refer to the rejection as a "Nonenablement Assertion." This is not appropriate. The rejection is for failing to comply with the written description requirement. Therefore, throughout Appellants' arguments, we will read "Nonenablement" as "Failure to Comply with the Written Description Requirement."

With respect to independent claim 1, the Examiner asserts at page 4 of the answer that the specification as filed shows (A), "[one] step does not occur as the result of the other, as claimed." The Examiner also points out (B), "[t]hese two processes operate on some of the same data, but they are [otherwise] separate processes that occur independently of each other." The two steps or processes being referred to by the Examiner are found at claim 1, lines 7-13 and lines 14-17 respectively.

Appellants argue at page 6 of the brief, "[a]s such, these two (2) processes are not 'separate processes that occur independently of each other' as alleged." Rather, they "are two processes in a single method." We find no conflict between what Appellants are arguing and what the Examiner has pointed out at (B) above. They are both saying the same thing. However, Appellants fail to address (A) above. Claim 1 requires that, "upon receipt of an indication from a user . . . checking . . .

Appeal No. 2003-1025
Application No. 09/224,918

to determine [perform the first process] [then perform the second process]."

To determine whether claim 1 has an adequate written description, we must first determine what is being claimed. Our reviewing court states, "[t]he terms used in the claims bear a 'heavy presumption' that they mean what they say and have the ordinary meaning that would be attributed to those words by persons skilled in the relevant art." **Texas Digital Sys. Inc v. Telegenix Inc.**, 308 F.3d 1193, 1202, 64 USPQ2d 1812, 1817 (Fed. Cir. 2002), **cert. denied**, 538 U.S. 1058 (2003).

Upon our review of Appellants' specification, we fail to find any definition of the term "upon" that is different from the ordinary meaning. We find the ordinary meaning of the term "upon" is best found in the dictionary. We note that the definition most suitable for "upon" is "on".² In turn, we find the ordinary meaning of the term "on" is best found in the dictionary. We note that the definition most suitable for "on" is "used to indicate occurrence at a given time."³

² **The American Heritage Dictionary, Second College Edition, 1982, page 1328. Copy provided to Appellant.**

³ **The American Heritage Dictionary, Second College Edition, 1982, page 867. Copy provided to Appellant.**

Appeal No. 2003-1025
Application No. 09/224,918

We have fully reviewed Appellants' disclosure as originally filed and find nothing directed to performing the three sub-steps at lines 8-11 of claim 1 when the given time is receipt of an indication from a user. Therefore, Appellants' argument is not persuasive.

Appellants also argue at page 8 of the brief that the process of claim 1 of the instant application is shown in claims 1 and 18-22 from the PARENT from which the instant application claims continuity. Claims 1 and 18-22 from the PARENT are reproduced at page 7 of Appellants' brief. Appellants' argument is not persuasive.

We have fully reviewed claims 1 and 18-22 from the PARENT application and find nothing directed to performing the three sub-steps at lines 8-11 of rejected claim 1 when the given time is receipt of an indication from a user. Although we agree with Appellants that inherently one process follows the other process, as the data must be put into the cache before it can be removed from the cache, the claims of the PARENT application do not recite a given time for the tracking and updating of the access cache. We find this to be consistent with the language of Appellants' specification at page 18 where the process that removed data from the cache occurs "on a regular, periodic basis to ensure security of the resources on the server." (Emphasis

Appeal No. 2003-1025
Application No. 09/224,918

added) Again, we find that Appellants' disclosure does not recite a "given time" for the occurrence of the three sub-steps at lines 8-11 of rejected claim 1.

Appellants also point out at page 9 of the brief that the specification at page 10, line 20, through page 11, line 4, discloses a process where the removal of data from the cache is triggered at a given time and the given time is the time recited in claim 1. We fully agree. However, the process at pages 10-11 of Appellants' specification is an alternative embodiment directed to different subject matter than lines 8-11 of claim 1. As such, we find this argument is not relevant to the claim before us, and is thus not persuasive.

Therefore, for the reasons discussed above, we will sustain the Examiner's rejection under 35 U.S.C. § 112, ¶ 1.

II. Whether the Rejection of Claims 1, 3-5, 7-11, 14-15, 17-25, 28-36, and 41 Under 35 U.S.C. § 112, ¶ 2 is proper?

It is our view, after consideration of the record before us, that claims 1, 3-5, 7-11, 14-15, 17-25, 28-36, and 41 are not indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Accordingly, we reverse.

With respect to independent claim 1, we agree with the Examiner that there is a serious problem with claim 1. However,

Appeal No. 2003-1025
Application No. 09/224,918

we do not find the claim to be indefinite. One skilled in the art would fully understand the if-then-else computer language statement that forms the bulk of claim 1. An artisan would understand that computer language syntax requires that, for example, the determining step is directed to checking the conditions at lines 8-11 of claim 1 with the determining step being followed by the removing step at line 12 if any of these conditions are met.

The problem in claim 1 is that Appellants have used computer language syntax rather than English language syntax as required by 37 CFR § 1.52 (b)(1)(ii). The Examiner should have objected to the claims on these grounds and required that the claims be rewritten in a proper English language syntax. We recommend that the Examiner add such an objection should there be any subsequent prosecution of these or similar claims.

Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 112, ¶ 2.

III. Whether the Rejection of Claims 37-40 and 42-49 Under 35 U.S.C. § 112, ¶ 2 is proper?

It is our view that, after consideration of the record before us, claims 37-40 and 42-49 are not indefinite for failing to particularly point out and distinctly claim the subject matter

Appeal No. 2003-1025
Application No. 09/224,918

which applicant regards as the invention. Accordingly, we reverse.

With respect to dependent claim 37, we do not find the claim to be indefinite. We find that one skilled in the art would fully understand the claim.

Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 112, ¶ 2.

IV. Whether the Rejection of Claims 1, 3, 7-11, 14-15, 17, 20-25, and 28-49 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1, 3, 7-11, 14-15, 17, 20-25, and 28-49. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a **prima facie** case of obviousness. **In re Oetiker**, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). **See also In re Piasecki**, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. **In re**

Appeal No. 2003-1025
Application No. 09/224,918

Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellants.

Oetiker, 977 F.2d at 1445, 24 USPQ2d at 1444. **See also Piasecki**, 745 F.2d at 1472, 223 USPQ at 788.

An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. "In reviewing the [E]xaminer's decision on appeal, the Board must necessarily weigh all of the evidence and argument." **Oetiker**, 977 F.2d at 1445, 24 USPQ2d at 1444. "[T]he Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion." **In re Lee**, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

With respect to independent claim 1, the Examiner states at page 6 of the answer that, "[f]or purposes of the [art] rejection of these claims, Examiner has interpreted the claims as including two separate [processes]." During our discussion of the rejection under 35 U.S.C. § 112, ¶ 1 above at Section I, we found that the disclosure as originally filed contains nothing directed to performing the three sub-steps at lines 8-11 of claim 1 when the given time is receipt of an indication from a user. (This is the claimed invention). Rather, the disclosure as originally

filed teaches removing data from the cache occurs "on a regular, periodic basis to ensure security of the resources on the server." That is, the disclosure as originally filed teaches there are two processes operating on some of the same data, but they are otherwise separate processes. (This is the disclosed invention.)

The Examiner has chosen to interpret and examine claim 1 as though it were the "disclosed invention" rather than the "claimed invention" recited in claim 1. This is not appropriate, as it does not comply with the requirements for the Examiner's action found in 37 CFR § 1.104 (a)(1), as follows:

On taking up an application for examination or a patent in a reexamination proceeding, the examiner shall make a thorough study thereof and shall make a thorough investigation of the available prior art relating to the subject matter of the claimed invention. **The examination shall be complete with respect** both to compliance of the application or patent under reexamination with the applicable statutes and rules and **to the patentability of the invention as claimed**, as well as with respect to matters of form, unless otherwise indicated. (Emphasis added)

The Examiner must examine the "invention as claimed" by the applicant even when there is an alleged conflict with the disclosure. Because the Examiner admits he has not examined the claim before us on appeal, we find that the Examiner has not met the initial burden of establishing a **prima facie** case of obviousness of claim 1.

Appeal No. 2003-1025
Application No. 09/224,918

Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 103.

V. Whether the Rejection of Claims 4, 5, 18, and 19 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 4, 5, 18, and 19. Accordingly, we reverse.

With respect to dependent claim 4, we note that the Examiner has relied on the Carlson reference solely to teach, "single tokens can identify a group of users" (Answer at page 26). The Carlson reference in combination with the Wobber reference fails to cure the deficiencies of Wobber noted above with respect to claim 1. Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 103(a) for the same reasons as set forth above.

Conclusion

We have not sustained the Examiner's 35 U.S.C. § 112, second paragraph, and 35 U.S.C. § 103(a) rejections of appealed claims 1, 3-5, 7-11, 14, 15, 17-25, and 28-49. We have, however, sustained the Examiner's 35 U.S.C. § 112, first paragraph, rejection of claims 1, 3-5, 7-11, 14, 15, 17-25, and 28-49, all of the claims on appeal. Therefore, the Examiner's decision

Appeal No. 2003-1025
Application No. 09/224,918

rejecting claims 1, 3-5, 7-11, 14, 15, 17-25, and 28-49 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

Gerry Smith
JERRY SMITH

JERRY SMITH
Administrative Patent Judge

Joseph E. Ruggier

JOSEPH F. RUGGIERO
Administrative Patent Judge

BOARD OF PATENT
APPEALS
AND
INTERFERENCES

Celler McDonald

ALLEN R. MACDONALD
Administrative Patent Judge

ARM/lbg

Appeal No. 2003-1025
Application No. 09/224,918

LEE & HAYES PLLC
421 W RIVERSIDE AVENUE SUITE 500
SPOKANE, WA 99201